

## REMARKS

Claims 1-19 were rejected. Claims 1 and 7 are amended, and claims 4-6 and 19 are cancelled herein. Claims 1-3 and 7-18 therefore are pending and under consideration.

### Revival of Patent Application

As set forth in detail in the accompanying cover letter for Renewed Petition under 37 C.F.R. § 1.137(b), Applicants herewith request reconsideration of the Petition to Revive the present patent application, which Petition was filed on February 25, 2008. The instant Response to the Office Action mailed on May 18, 2007, is believed to satisfy the requirement for a "required reply" under 37 C.F.R. § 1.137(b), as detailed in MPEP 711.03(c)(II)(C) and (D).

### Claim Amendments

The claims have been amended to more particularly point out Applicant's claimed invention. No new matter has been added.

Claim 1 has been amended, in part, to recite that the atomized activating composition on to the dental surface follows the application of the whitening composition to the surface. This amendment incorporates the subject matter of claim 6 into claim 1. Claim 7 is also amended, to properly depend from claim 1 rather than from cancelled claim 6. The amendments to claim 1 are supported in the as-filed specification, and for example, in paragraph [0012] and in original claims 6 and 7.

### Rejections Under 35 U.S.C. § 103(a)

1. Claims 1-7, 9, 10, 12-14, 17 and 19 were rejected as allegedly being obvious over Montgomery (U.S. Patent No. 6,958,144) in view of Summers (U.S. Patent No. 5,611,690). It is the Examiner's view that Montgomery, in view of Summers, would lead one of skill in the art to arrive at claims 1-7, 9, 10, 12-14, 17 and 19, in their entirety. Applicants respectfully traverse the Examiner's rejection for the following reasons.

As a preliminary matter, Applicants note that claims 4-6 and 19 were cancelled herein and the subject matter of claim 6 incorporated into claim 1. Inasmuch as the Examiner may apply the rejection to the amended claims and the claims depending therefrom, Applicants submit that the claims are not obvious.

The test which must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103 ...

[T]he four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations. (MPEP § 2141)

None of these criteria have been met here.

When applying 35 U.S.C. § 103(a), the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined (MPEP § 2141 II).

The rejection states that Montgomery teaches the application of an activating composition to the dental surface prior to the application of a whitening composition to the dental surface. Applicants point out that claim 1, and the remainder of the claims that depend therefrom, do not encompass application of an activating composition to the dental surface prior to the application of a whitening composition to the dental surface. As amended, independent claim 1 is directed to a method comprising the application of an *atomized* activating solution to the dental surface *following* the application of a whitening composition to the dental surface. Montgomery does not disclose or even

suggest the application of an activating solution to the dental surface following the application of a whitening composition.

Applicants' claimed invention encompasses the application of a whitening composition onto the tooth surface, followed by application of an activating agent onto the whitening composition that is on the tooth surface. Applicants teach that the application of an activating agent to a dental surface following the application of a whitening composition to that surface surprisingly enhances the extent and rapidity of tooth whitening. See, e.g., paragraphs [0037] and [0039].

Not only does Montgomery not teach or suggest the application of an activating solution to the dental surface following the application of a whitening composition, but Montgomery, in fact, teaches away from the application of an activating solution following the application of a whitening composition. Montgomery does not teach an "activating solution" per se. However, Montgomery discloses the use of an alkalinizing agent prior to the application of a whitening composition to a tooth surface. When Montgomery discloses the use of an alkalinizing agent, it is specifically described that the method of Montgomery can be practiced by raising the pH of the tooth surface prior to any contact of the tooth surface with a whitening composition (see, e.g., column 3, lines 22-30 and column 4, line 64 through column 5, line 8). When Montgomery is read in its entirety, for all it fairly teaches, the skilled artisan would understand Montgomery to provide the teaching and/or suggestion that the alkalinizing agent must be on the surface of the tooth before the surface of the tooth is covered by the whitening composition. This teaches away from Applicants' surprising findings that application of an activating agent, such as an alkalinizing agent, after the tooth surface has already been covered by a whitening composition, can provide superior tooth whitening results.

The rejection acknowledges that Montgomery does not disclose an atomized activating solution, and refers to Summers as a motivation for the application of an atomized activator to the tooth surface. However, not only does Summers not teach or suggest the application of an activator solution to a tooth surface, but Summers does not correct the deficiencies of Montgomery.

Summers discloses the application of a whitening composition to a tooth via atomization of a whitening composition. Summers does not teach or suggest the inclusion or use of an activating agent, nor does Summers teach or suggest the application of an activating agent to a tooth surface. Summers teaches the use of a single container to apply a single composition to the tooth surface. However, because it is well known in the art that hydrogen peroxide bleaching solutions, such as those utilized by Summers, are only stable for appreciable periods of time under acidic conditions, Summers also teaches away from the presently-claimed invention. The skilled artisan would view Summers as teaching a method of tooth whitening that could only be workable if the stock whitening composition is kept at an acidic pH, and therefore, teaching that the use of the devices and methods of Summers would be incompatible with any type of an alkalinizing agent.

Assuming, *arguendo*, that the skilled artisan somehow found some level of motivation to apply the alkalinizing agent of Montgomery to the tooth surface using a device as taught by Summers, the skilled artisan would – at best – be motivated to use such a device according to those methods taught by Montgomery. Again, this leads the skilled artisan *away* from Applicants' presently-claimed invention, because the skilled artisan would understand Montgomery to provide the teaching and/or suggestion that the alkalinizing agent must be on the surface of the tooth before the surface of the tooth is covered by the whitening composition.

Because the skilled artisan would not find the teaching, suggestion or motivation in the cited prior art to administer an activating agent to the dental surface after a whitening composition has already been applied to the surface, the skilled artisan would have no reasonable expectation of success in arriving at Applicants' presently-claimed invention. Accordingly, the combination of Montgomery and Summers does not render amended claims 1-3, 7, 9, 10, 12-14 and 17 obvious.

2. Claims 8, 11 and 18 were rejected as allegedly being obvious over Montgomery in view of Summers, and further in view of Gaffar (U.S. Patent No. 5,648,064). It is the Examiner's view that Montgomery and Summers, in view of Gaffar, would lead one of

skill in the art to arrive at claims 8, 11 and 18, in their entirety. Applicants respectfully traverse the Examiner's rejection for the following reasons.

Montgomery and Summers do not apply for the reasons set forth in detail above. The further application of Gaffar does not remedy the deficiencies of Montgomery and Summers. While Gaffar is purported to disclose a mouthwash, dentifrice, oral strip, liquid whitener, or chewing gum that comprises a specific concentration of a peroxy compound, Gaffar does not provide any teaching or suggestion of applying an activating agent to a dental surface following prior application of a whitening composition. At most, Gaffar, when read for all it fairly teaches, might be understood to teach the combination of an alkaline agent with a peroxide-based whitening agent in order to prepare an enhanced bleaching mixture for subsequent application to the teeth.

Because the skilled artisan would not find the teaching, suggestion or motivation in Gaffar, Summers, or Montgomery to administer an activating agent to the dental surface after a whitening composition has already been applied to the surface, the skilled artisan would have no reasonable expectation of success in arriving at Applicants' presently-claimed invention. Accordingly, the combination of Montgomery and Summers with Gaffar does not render obvious claims 8, 11 and 18, which ultimately depend from amended claim 1.

3. Claims 15 and 16 were rejected as allegedly being obvious over Montgomery in view of Summers, and further in view of Banerjee (U.S. Patent No. 6,485,709). It is the Examiner's view that Montgomery and Summers, in view of Banerjee, would lead one of skill in the art to arrive at claims 15 and 16, in their entirety. Applicants respectfully traverse the Examiner's rejection for the following reasons.

Montgomery and Summers do not apply for the reasons set forth in detail above. The further application of Banerjee does not remedy the deficiencies of Montgomery and Summers. While Banerjee is purported to disclose the use of sodium bicarbonate as a basifying agent, Banerjee does not provide any teaching or suggestion of applying an activating agent to a dental surface following prior application of a whitening

composition. At most, Banerjee, when read for all it fairly teaches, might be understood to teach the combination of an alkaline agent with a peroxide-based whitening agent in order to prepare an enhanced bleaching mixture for subsequent application to the teeth.

Because the skilled artisan would not find the teaching, suggestion or motivation in Banerjee, Summers, or Montgomery to administer an activating agent to the dental surface after a whitening composition has already been applied to the surface, the skilled artisan would have no reasonable expectation of success in arriving at Applicants' presently-claimed invention. Accordingly, the combination of Montgomery and Summers with Banerjee does not render obvious claims 15 and 16, which ultimately depend from amended claim 1.

SUMMARY

Applicant believes that claims 1-3 and 7-18 are in condition for allowance and favorable consideration is solicited. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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